REMARKS

Claims 15-33 are pending in the Application. Claims 1-14 have been cancelled. Claims 15-23 are repeated in this continuation case from the parent case Serial No. 09/969,343 filed on October 1, 2001. Claims 24-33 have been added. Of the claims remaining in the case, claims 15 and 22-25 are independent claims.

The pending claims are directed to a method of recording a personal message to present to a recipient or a listener receiving a gift, or a method of recording and delivering a message for shipment to a recipient. While today's high tech and fast-paced lifestyle has led others in the pertinent field of art to attempt to provide a methodology by which a remote purchaser may send a personalized voice greeting to a recipient along with a card or gift, Applicant respectfully contends that there is ample evidence in the record demonstrating that the claimed methods are novel and non-obvious in view of the prior art. In short, Applicant has made a valuable contribution to the art of remote voice message recording that is deserving of patent protection. Because the claimed methods for accomplishing such recording and delivery of voice messages are neither anticipated by nor made obvious in light of the prior art of record, as set forth in more detail below, Applicant respectfully urges that the pending method claims be passed to immediate allowance.

Regarding independent claim 15, there is recited a method of recording a personal message to present to a recipient including: selecting a product with a pocket for receipt of a voice module of a predetermined configuration; selecting a voice module of said predetermined configuration and of the type including an electrical contact; selecting a recorder-imprinter device including a housing with a port configured to complementally receive said voice module and including an electrical receptacle engageable with said electrical contact, a storage device for receiving and storing said personal message, and a microprocessor in circuit with said receptacle and said storage device and operative in response to a stored said personal message to generate said analog signal; downloading said personal message to said storage device of said recorder-imprinter; inserting said voice module in said port to engage said contact with said receptacle to receive said analog signal and record it on said solid state memory; and removing said voice module from said port and inserting it in said pocket and delivering said product to said recipient. As such, the claimed method provides the distinct advantages of remote downloading of a personal message directly to a store front recorder-imprinter and subsequent recording of the message onto a voice module that may then be inserted in a pocket of the same size and shape provided in the product to be sent to the recipient, whether a card or a gift. Thus, the present method allows for more streamlined operation by eliminating entirely the need for a central facility computer system or the like while providing for more versatility through the recording of the message onto a voice module separate from and insertable into a number of different products, including greeting cards.

This method should be contrasted with the systems and methods for recording and delivering personalized audio messages such as those shown in U.S. Patent No. 5,444,767 to Goetcheus. Goetcheus teaches at column 3, lines 3-4, that "[a] preferred embodiment of the portable playback device is a greeting card," which structure is antithetical to the recited pocket into which a separate voice module is to be inserted. Clearly, Goetcheus discloses that the portable playback device circuitry is integral with the greeting card – that the circuitry and greeting card together form the portable playback device 16, as best shown in Figure 1 of the '767 patent. In the Goetcheus system, then, there is not a separate voice module and greeting card and, thus, there is simply no need for the steps of "selecting a product with a pocket for receipt of a voice module" and, after recording an analog signal representing the personal voice message onto the voice module, "inserting [said voice module] in said pocket and delivering said product to said recipient" as recited in claim 15. Thus, the Goetcheus disclosure does not teach or suggest any kind of pocket in a greeting card or the like for receipt of a voice module as claimed. On this basis alone, it is respectfully urged that claim 15 should be allowable.

Moreover, throughout the Specification of the present application, such as at page 27, lines 4-11, and page 29, lines 1-9, it is made clear that the recited steps in claim 15 of "selecting a product with a pocket for receipt of a voice module of a predetermined configuration" (emphasis added), "selecting a voice module of said predetermined configuration" (emphasis added), and "selecting a recorder-imprinter device including a housing with a port configured to complementally receive said voice module" (emphasis added) all relate to the specific shape formed in the respective pocket, voice module and recorder-imprinter programming port. Specifically, it is explained that the port is configured with side walls, an end wall and a diagonal wall, or first indexer, between the end wall and the left side wall so as to only compliment the profile of the voice module when it is inserted in one way. Thus, the configuration of the voice module, and particularly the diagonal wall, or second indexer, of the voice module's casing, serves to orient and align the voice module in the port to insure proper mating and electrical contact between the port's female receptacle and the contacts of the voice module. In the same way, it is disclosed that the perimeter of the pocket formed in the card or gift is also configured to match the profile of the voice module casing, including the diagonal wall, so that the voice module can only be fully inserted one way, insuring that the voice module is properly positioned within the card or gift pocket and that the manual actuator of the voice module will be adjacent to a corresponding marked area on the card or gift indicating where the recipient is to push or squeeze to initiate playback of the message from the voice module.

In contrast to the recited method, the schematic of Figure 4 of the Goetcheus patent has no shape, or predetermined configuration, nor is such a predetermined configuration disclosed by or even important in the Goetcheus system, as would be expected in such a system in which, as explained below, the playback circuitry is not separate from the greeting card and is not complementally received by the programmer. Thus, the Figure 4 schematic cannot possibly anticipate or make obvious claim 15, or the "predetermined configuration" limitation specifically. Because no structure relating to such a predetermined configuration of the voice module for complimentary receipt in either the recorder-imprinter port or the product pocket, or corresponding steps involving such structure as recited in claim 15, are taught by Goetcheus, alone or in combination with any other prior art references, it follows that claim 15 is allowable on this basis as well.

The method of claim 15 is also contrasted with the Goetcheus reference, alone or in combination with U.S. Patent No. 6,356,626 to Ohara, as to the recited step of inserting the voice module in the port of the recorder-imprinter to engage the voice module contact with the port's receptacle so as to receive the analog signal and record it on the solid state memory of the voice module. Because, as stated above, the Goetcheus system entails the recording of a voice message to playback circuitry pre-installed within a greeting card or the like, it is necessary for the store front programmer system 14 to be configured with the disclosed external programmer data lines 24 to plug into the card's circuitry, as shown in Figure 1 of the '767 patent. Therefore, it is clear that Goetcheus fails to teach "an electrical receptacle" and, thus, the recited step of inserting the voice module into the recorder-imprinter port so as to engage the voice module contact with such a receptacle to transfer a message to the voice module memory. Furthermore, it would be impossible to plug the Goetcheus card-shaped portable playback device into a recording bay receptacle such as disclosed by Ohara, which is why Goetcheus teaches only the external data lines. It follows that the "receptacles" taught at column 11, line 28, of Ohara can in no way be reasonably combined with the Goetcheus system, nor is any suggestion to do so provided anywhere in either reference. Rather, by employing a greeting card with integral playback circuitry that necessitates external programmer lines, Goetcheus actually teaches away from the use of any such receptacles as taught by Ohara, much less the recited port configured for insertion of the voice module so as to engage the port's receptacle with the voice module's contacts for the transfer of a message to the memory of the voice module. Again, this versatility provided by the claimed method is wholly distinct from and patentable over the prior art. Thus, Applicant respectfully urges that claim 15 is in condition for immediate allowance as amended.

As for the Ohara reference, specifically, Applicant also contends that the recited step in claim 15 of "downloading said personal message to said storage device of said recorder-imprinter" is functionally impossible in the Ohara system. Ohara is generally directed to a system and method for recording a personal audio greeting onto a voice message recording/playback device locally or remotely. The system is said to employ a single, multipurpose processor to record to the recording/playback device for local or remote delivery without the need for expensive switching and voice processing hardware. As such, the Ohara system essentially includes two components: a point-to-point processor (12) and a voice message recording/playback device (22). The processor is a stand-alone unit having an internal circuit board configured with receptacles (154, 156) for independently receiving the recording/playback device and with control circuitry for selectively operating the receptacles to transfer a voice message to or from the recording/playback device. See Fig. 5; col. 11, lines 21-64. The voice message recording/playback device (22) is generally a card-shaped device having a circuit board (22') enclosed within a plastic cover (258) and functioning to record, store and play back a personal audio message. The circuit board includes a female pin connector (256) that is configured both to be received within the respective processor male pin receptacles (154, 156) or to connect to a detachable microphone device (24) through which the recording/playback device can be directly recorded. In an alternative embodiment of the Ohara system, the recording/playback device may be configured with an internal microphone wired to the circuit board for recording directly to the device. Central to the recording/playback device's circuitry is a single chip voice message system which is capable of direct storage of analog signals within the chip's non-volatile memory. See Figs. 6, 7; col. 11, line 65 - col. 13, line 5.

From the foregoing recited structure, it is critical to note that Ohara discloses only that the circuitry of the recording/playback device (22) is equipped with a memory location for electronically storing a customer's audio greeting, while the point-to-point processor (12) has no such memory location, but acts only to transfer voice files to and from recording/playback devices appropriately connected to the processor. In use, then, Ohara's multiple point-to-point processors (12) in separate locations may each be connected to a public telephone network through their respective phone jacks (170). Under one scenario, a customer might call a first vendor location having a first processor in order to purchase a gift and a recording/playback device containing the customer's personal greeting to accompany the gift. After the vendor has taken down the customer's order information, including the length of greeting the customer would like to make, the vendor would then select from his inventory an appropriate recording/playback device (22) and insert it into the processor's "record" receptacle (154). After providing the customer with preliminary instructions, the vendor would switch the mode setting (152) on the processor to "record" and to cause the processor to prompt the customer through the process of recording the customer's message to the recording/playback device. In this first scenario, then, where the gift the customer desires to send is located at the first vendor location with the now-recorded voice message recording/playback device (22), after the customer has completed recording, the vendor may remove the device from the processor (12) and place it with the gift for shipment.

Under an alternative scenario disclosed in the Ohara reference, the gift the customer desires to send may be located at a remote second vendor location. If the second vendor is also equipped with a point-to-point message processor (12), the customer's previously recorded audio greeting may be transferred to the second vendor location for storage onto a second recording/playback device (22) to accompany the gift. The first vendor would first remove the previously-recorded device from the first processor's "record" receptacle (154), and insert it into the processor's "transmitting" receptacle (156). With the mode selector (152) set to "telephone," the first vendor may then call the second vendor using the store telephone (18) and inform the second vendor of the order and that a customer's previously recorded audio greeting is to be transferred to the second vendor location. After the first vendor has relayed all pertinent information relating to the customer's order to the second vendor, including the length of the message, the second vendor inserts an appropriate second recording/playback device into the "record" receptacle (154) of the remote second processor and switches the second processor to "record," which temporarily disconnects the second vendor's telephone from the phone line and readies the second processor to receive the customer's previously recorded message when played back by the first processor by the first vendor. To do so, the first vendor would switch the first processor's mode selector to "transmission" and then press the "transfer" button (158) to cause the first processor to emit a "DTMF tone" that puts the first recording/playback device in play mode and the remote second recording/playback device in record mode. When the transmission is complete, the newly-recorded second recording/playback device at the remote second location can be removed from the second processor and placed with the gift, while the first recording/playback device, which essentially "functioned as a temporary mail-box, may be re-used to record another customer's voice message."

In a third scenario disclosed by Ohara, a customer present at a first vendor's location may elect to send a recording/playback device (22) containing the customer's personal audio greeting with the gift to the intended recipient. The vendor would provide the customer with a device and a microphone attachment (24) so that the customer can record a greeting onto the device right in the store. To connect the microphone attachment to the recording/playback device for use, the attachment's male pin connector (260) is inserted into the device's female receptacle (256). To record, the customer would then press and hold the "record" button (710) and speak into the microphone until finished or the device times out. Once the greeting has been satisfactorily recorded, the customer returns the recording/playback device and the microphone attachment to the vendor and completes the transaction. The very device on which the customer recorded his or her greeting may then be shipped to the recipient with the gift from the first vendor location, or if the desired gift is at a second vendor location, the recording/playback device may serve as temporary memory (mail box) for then transmitting the greeting to a second vendor location through the processors as summarized above. See Figs. 1, 5 and 6; col. 6-9.

Critically, in any of the above scenarios describing the use of the Ohara system, the point-to-point processor functions only to transfer voice messages to and from a recording/playback device and never stores a customer's message itself. At column 11, lines 28-31, Ohara describes the processor's recording/playback device as including a circuit board "including receptacles for receiving voice message recording/playback devices and circuitry for operating the same to record and transfer a message thereon and therefrom" (emphasis added). Only the recording/playback device has a memory location for storing the customer's voice greeting, such that even in the situation where the customer desires to record his or her voice message at one location and have the gift that the message is to accompany sent from a remote second location, Ohara explains that the first-recorded recording/playback device serves as a "temporary mail-box" from which the message can be sent to a second recording/playback device through the interconnection of the processors. In fact, in touting the system, Ohara expressly distinguishes over U.S. Patent Nos. 5,063,698 to Johnson and 5,425,078 to Stern as disclosing systems that require a central voice processor or automated computer network, reasoning that this arrangement is "inadequate" and does not "provide for the real-time transfer of the customer's voice message" directly to and from the recording/playback device. See column 3, lines 12-40.

In contrast to Ohara, the recorder-imprinter disclosed in the present application has an internal microprocessor that directs all modes of its operation and is configured with two types of non-volatile memory devices: (1) a solid state random access memory ("RAM") device for the temporary storage of data files representing a customer's order information and voice message; and (2) a read only memory ("ROM") device for permanent storage of the recorder-imprinter's operating program and digitized voice prompt data. It is noted that the RAM device may store customer data in analog or digital format and hold "up to a fixed number of voice messages (50, 100, etc.), depending on how the RAM device is configured." See Specification, page 21, line 14 - page 22, line 4.

In use, the system disclosed in the present application entails linking a recorder-imprinter to a retailer's phone system so that in-coming calls can be transferred by a shop clerk to the recorder-imprinter. When a customer calls or comes by the retailer's store to order or a gift to be sent to a recipient along with a personal voice greeting, the customer may interact with the recorder-imprinter by following its prompts through the recording process. Whether the customer has recorded his or her greeting remotely or in person at the store through the recorder-imprinter's handset, the greeting is stored in the RAM memory device of the recorder-imprinter along with the customer's order number for later transfer or recording to a voice module by the store clerk or other operator. In an alternative embodiment of the present system, a personal computer ("PC") is employed in the remote recording of an audio message. In this case, a customer might call in to a larger distribution operation to place a gift order. If the customer would like to send a personalized audio greeting card with their order, the operator would then transfer the call to an on-site PC running software according to the present invention that would then prompt the customer through the voice message recording process. At some point after the customer's voice message is recorded, a clerk or operator at the PC would initiate the download of the stored voice file to the appropriate recorder-imprinter's RAM memory using the software on the PC. With the recorder-imprinter properly connected to the computer network across either a USB or COM port, the file transfer is possible without the involvement of the clerk at the store or distribution center where the recorder-imprinter is located. A fourth embodiment of the present system involves storing a customer's voice file in a recorder-imprinter's RAM memory at a first location and subsequently transferring the file to a recorder-imprinter at a second location where the voice message would subsequently be transferred to a voice module to accompany a gift or card being sent to a recipient.

In each embodiment, ultimately, the customer's order number and voice message are stored in the RAM device of the recorder-imprinter at the location where a voice module is to be recorded with the customer's voice message in order to accompany a gift or card to a recipient. At any point after the file is so stored, a clerk or other operator, or the customer if he is recording on-site, may download any such previously-recorded voice message onto a voice module using the recorder-imprinter. The user would initiate this process by inserting a blank voice module into the recorder-imprinter's programming interface port, which may automatically activate the programming mode. The user may then scroll through the files currently stored in the RAM memory of the recorder-imprinter and, when the desired file is located, press the appropriate PROG button on the recorder-imprinter to begin the transfer to the voice module. When the transfer is complete, the user will be prompted to remove the voice module from the recorder-imprinter, which can then be placed in a card or gift.

Therefore, in contradistinction to the Ohara system in which only the recording/playback device is configured with a memory location and the point-to-point processor is merely a means for passing a customer's voice message to or from a recording/playback device, the recorder-imprinter of the present invention is equipped with a RAM memory device for storing up to 50 or 100 voice messages at a time for selective subsequent transfer to a voice module or uploading to a PC for transfer to a second location having a recorder-imprinter unit. This feature offers the advantage of bypassing a central facility computer system or the like while still allowing for storage and manipulation of multiple messages right at the recorder-imprinter for later transfer to an individual voice module plugged into the recorder-imprinter port. In sum, then, the Ohara system only entails recording to and transferring from the memory of the recording/playback device, not the processor, while the presently claimed method expressly includes the step of "downloading said personal message to said storage device of said recorder-imprinter," impossible in the Ohara system, as demonstrated above. Hence, because the Ohara processor simply does not contain a memory "storage device" of any kind for storing even one voice message, it is clear that Ohara cannot anticipate or make obvious claim 15, alone or in combination with other references such as Goetcheus.

Applicant notes that following the recited step in claim 15 of recording the personal message to the recorder-imprinter's memory, the next step recited is to then insert the voice module into the recorder-imprinter's port to receive the analog signal representing the personal message and store it in the voice module's solid state memory. Based on these acts, it is noted that the redundant recitation at line 14 of claim 15 of placing the voice module in the recorder-imprinter port is unnecessary and was deleted as being a clerical mistake. Applicant also notes that at line 15 of claim 15, it was discovered that there is an antecedent problem regarding the "personal message" recited in lines 1, 11 and 13 of the claim. At line 15, the term "said voice message" (emphasis added) was used instead. Because the antecedent basis is the "personal message" of line 1, line 15 has been amended accordingly to properly recite "said personal message" (emphasis added). Applicant respectfully contends that these changes to claim 15 are clerical, add no new matter to the application, and have not been made for a reason related to patentability.

Because claim 15 is, then, allowable as being unanticipated by and unobvious over the art, it would follow that all claims depending from claim 15, or claims 16-21, are also allowable, as each such claim only adds further limitations on a method that has been shown to be clearly patentable. Furthermore, additional independent bases exist for the patentability of claims 16-21, as set forth below.

Turning first to dependent claim 16, the recited step of "downloading said voice message to said storage device of said recorder-imprinter" is further limited as including steps related to transferring a customer's telephone call to the recorder-imprinter. Specifically, those additional steps include "connecting said telephone call to said recorder-imprinter device" and "prompting the recording of said audio message." These steps again provide the benefit of obviating the need for a central facility computer system or the like to which a customer's call must be connected and to which the customer's voice message is recorded before being subsequently transferred to a playback device through a remote processor. Rather, the method of the present invention is streamlined and allows for a customer's call to be connected directly to the remote recorder-imprinter.

In contrast to the recited method of recording a personal message, Goetcheus only discloses that a voice message be recorded at the central facility computer system 12. In fact, at column 9, lines 13-17, of the '767 patent, it is unequivocally explained that a customer's call is either directly received at the central facility or, if made to a store front, is transferred to the central facility for recording of a voice message. Language at column 2, lines 38-41, states that "the sender communicates via a telephone line with the central facility system" (emphasis added), not with the store front programmer system. Goetcheus simply discloses no means or suggestion for connecting a customer's call to a store front programmer. Further, Goetcheus actually teaches away from recording over the phone to the store front device by touting the supposed advantages of having all calls routed to a central facility for recording of voice messages for subsequent transmission to individual store front programmer systems. Thus, because Goetcheus not only does not teach the steps recited in claim 16 relating to direct recording over the telephone to a remote recorder-imprinter, but actually teaches away from such steps, it follows that claim 16 is also not obvious over Goetcheus alone or in view of Ohara.

Moreover, it is intuitively obvious that because the recitations of claim 16 relate to the remote recording of a personal message directly to the recorder-imprinter over the telephone, it must be the case in this claimed embodiment that the recited step of "prompting the recording of said audio message" is audible prompting, as clearly supported by the Specification, such as at page 21, lines 2-5. Therefore, any reference to the LED recording light prompt disclosed by Ohara, which would necessarily be a visual prompt and relate to in-person, rather that over-the-phone, recording or downloading of a voice message, as a basis for rendering claim 16 obvious would be unfounded and truly nonsensical. In fact, the LED recording light disclosed at column 9, lines 34-39, of the Ohara patent relates to a visual signal to an agent operating a message processor that the processor is in record mode and has nothing to do with prompting a user to record a voice message, much less remotely over a telephone. Therefore, there is no suggestion for the step of "prompting the recording of said audio message" recited in claim 16 in either Goetcheus or Ohara, alone or in combination, further evidencing that claim 16 should be immediately passed to allowance.

As for dependent claims 17-19, the recited step of "downloading said voice message to said storage device of said recorder-imprinter" is further limited as including steps related to configuring a personal computer with an audio message recording software program, selecting said recorder-imprinter to further include a computer interface, linking said personal computer to said recorder-imprinter through said computer interface, interacting said software program so as to store said voice message in said personal computer, and transmitting said voice message to said recorder-imprinter device. Thus, claims 17-19 recite a method by which a personal message is downloaded to a recorder-imprinter through a personal computer, rather than directly in person or over the telephone.

In contrast to the recited step of "configuring a personal computer with an audio message recording software program," the "central facility computer system" of Goetcheus is no more than a voice mail system. Goetcheus gives no indication that the central facility is capable of running software or of being interacted with in any manner as a user would a personal computer. Rather, while Goetcheus discloses connection with the central facility over both a conventional telephone line and other digital or satellite communication networks, nowhere does Goetcheus disclose connecting with the central facility using a conventional computer interface such as a COM or USB serial connector as employed in the present system. Simply put, Goetcheus does not teach anything remotely resembling or functioning as a "personal computer with an audio message recording software program" or a "computer interface" as recited in claims 17-19. It follows, then, that Goetcheus also does not disclose the recited step of "interacting said software program so as to store said voice message in said personal computer." Therefore, Applicant contends that claims 17-19 are also patentable as being nonobvious over Goetcheus in view of Ohara.

Turning now to claim 20, Applicant contends that this claim is allowable as depending from and further limiting nonobvious dependent claim 16, discussed above. Specifically, again, there is no teaching or suggestion in Goetcheus, alone or in combination with Ohara, for direct telephone recording of a voice message to a store front programmer system for later storage in a playback device. In fact, there is no provision within the Goetcheus system for a telephone call to ever be received by the store front programmer system, let alone configuring such a programmer system to automatically seize an incoming call and begin prompting a customer through the voice message recording process as recited in claim 20. Where all of the limitations in a pending claim are not taught by a single prior art reference and multiple references must be looked to, in combination, to meet each of the claim limitations, the cases make clear that the suggestion to combine the necessary elements from the various references relied upon must come from those references. As such, in addressing whether a particular combination of reference elements is suggested, or even feasible, it is equally clear that the purposes and objects of the respective references are highly relevant. In the case of the Goetcheus and Ohara references, for example, there is no suggestion in either for the combination of any of their features relating to telephone recording of a voice message or otherwise. These references disclose different systems designed to serve different purposes. Indeed, the purposes served by the Goetcheus system of centralizing order taking through the central facility through which all telephone calls are routed teach away from the Ohara system wherein remote programming systems stand and function alone without any centralized voice message system whatsoever. Specifically, again, Goetcheus neither discloses nor suggests receiving a telephone call directly by the store front programmer system, let alone the claimed steps of automatically seizing an incoming call when a selection button on the recorder-imprinter is pressed and then prompting a customer through the voice message recording process. On these bases, Applicant contends that claim 20 should also be passed to immediate allowance.

Regarding dependent claim 21, Applicant respectfully urges that this claim is patentable as depending from and further limiting independent claim 15, which has been shown above to be nonobvious and patentable over the prior art, including Goetcheus. Moreover, regarding the Ohara reference, Applicant notes that Ohara clearly does not in any way disclose that the point-of-sale telephone 18 would be used by a customer to record a voice greeting to a recording/playback device when the customer is physically present at the store. Rather, at column 7, line 64 - column 8, line 13, Ohara makes abundantly clear that a customer present at the point of sale would be given a recording/playback device 22 and a direct record input device 24, or microphone attachment, which he or she would connect to the device to record his or her voice message. This is the only means disclosed by Ohara for in-person recording to the recording/playback device, and there is absolutely no suggestion that a customer would ever record a voice greeting to the recording/playback device through the store telephone 18 or any other handset. Therefore, Applicant contends that on this basis, as well, claim 21 is in condition for immediate allowance.

Turning now to independent claim 22, there is recited a method of recording and delivering a message for shipment to a recipient, including the steps of receiving a telephone order from a caller, recording the telephone caller's identification and recording his or her personal message in a storage device, converting the message to an analog signal, selecting a voice module including a power supply, memory device, speaker and switch, and recording the analog signal representing the personal message on the memory device of the voice module such that when the recipient selectively operates the switch the circuit between the power supply and the speaker is closed so as to transmit the analog signal to the speaker and generate an audio signal to propagate to the recipient.

In contrast, no such steps are disclosed or even suggested by Goetcheus, Ohara or U.S. Patent No. 6,449,345 to Grimes. Specifically, both Goetcheus and Ohara fail to teach the step of recording the caller's identification as recited in claim 22. The Grimes reference is directed to a voice mail system, and, particularly, to an improved means for remote access of previously recorded voice mail messages based on selection criteria such as the originating phone number or area code, the identity of the caller, or the time of day of the call. There is absolutely no suggestion that such selective playback criteria, or the recording of any such information, would be beneficial in a playback device programmer system or portable playback device as disclosed by Goetcheus or in a point to point voice message processor and recording/playback device as disclosed by Ohara. On this basis, Applicant respectfully urges that claim 22 is also directed to patentable subject matter not rendered obvious by the prior art.

Regarding independent claim 23, Applicant notes that this claim also contains limitations related to telephone recording directly to the memory of the recorder-imprinter, as in claim 16, such that it follows that claim 23 is simply not rendered obvious by the prior art, including Goetcheus or Ohara, alone or in combination. Moreover, claim 23 recites other limitations similar to those of claim 15 that are neither found in nor suggested by the prior art. For example, claim 23 recites that the gift have a pocket for receipt of a voice module of a predetermined configuration and that the recorder-imprinter be configured with a port having an electrical receptacle engageable with the voice module's electrical contact, none of which is taught or suggested by any combination of Goetcheus with Ohara, as explained previously regarding claim 15. Based on these observations, Applicant respectfully contends that claim 23 is neither anticipated by nor obvious over the prior art, such as Goetcheus in view of Ohara, and, on that basis, requests that the claim be passed to immediate allowance as amended.

Further regarding amended claim 23, Applicant discovered that a redundant step was included in the original claim at line 15, which step is also incorporated in the step recited at lines 18 and 19. Therefore, the entirety of line 15 has been deleted from the claim, as indicated. Applicant further notes that a similar redundancy was included in original independent claim 15, which has also been deleted as part of this pre-prosecution Amendment.

With regard to the new claims that have been added in the application, independent claim 24 recites method steps and corresponding structure relating to the use in the present invention of direct telephone recording of a voice message to a remote recorder-imprinter device, and specifically, the steps of transferring a telephone call to the recorder-imprinter over a telephone line connection by pressing a selection button on the recorder-imprinter to cause the recorder-imprinter to automatically seize the telephone call through a telephone interface device and prompting the personal message, as neither taught nor suggested by any of the prior art, alone or in combination, as set forth above regarding claims 16 and 20. Newly added independent claim 25 is directed to the use in the present invention of a personal computer with an audio message recording software program to download a voice message to a recorder-imprinter. Again, this system and method of use has been shown to be nonobvious over the art, as set forth above regarding claims 17-19. For these reasons, Applicant respectfully urges that claims 24 and 25 are in condition for allowance as submitted.

Claims 26-33 further specify the use of a personal computer and accompanying software within the presently claimed method of recording a personal message to present to a recipient such as not taught by the prior art. Regarding claims 25-33, Applicant notes that clear support for the recited method steps are found in the Specification at pages 21-25. Thus, Applicant urges that claims 26-33 be passed to immediate allowance as well.

Regarding dependent claim 26, specifically, there is recited a method wherein the step of interacting the software program running on the personal computer further comprises co-locating a user and the personal computer, configuring the personal computer with a microphone for audible receipt of the personal message, and running the software program so as to prompt the user through the storing of the personal message. While it could be argued that use of a microphone in connection with a personal computer is known in the art, Applicant contends that no such use of a personal computer, alone or in combination with a microphone, is disclosed or taught in the art in connection with a remote voice message recording system or the like. This is particularly true in view of the fact that no known prior art even contemplates or suggests any benefit for recording a voice message in person at a computer for later downloading to a recorder-imprinter for recording to a voice module to accompany a card or gift. Specifically, Applicant notes that in both Goetcheus and Ohara no personal computer is even disclosed, much less a voice message recording system in which such a personal computer would be interacted with in person so as to record the voice message through a microphone connected to the personal computer. Ohara teaches no computer system of any kind, but only direct recording to the playback device over the phone through a point-to-point message processor or in person through a direct record input device. In Goetcheus, the central facility computer system is only disclosed as being remote from a customer and accessed by telephone, while the only in-person recording through a microphone is taught as being at the store front playback device programmer system. This follows logically from the above discussion related to claims 17-19 in which Applicant noted that the Goetcheus central facility computer system is nothing more than a voice message system, which would never be interacted with directly as one would a personal computer. Simply put, Goetcheus only contemplates use of the central facility computer system as a voice mail system that is connected to by a user over the telephone, and there is no teaching that the central facility, regardless of where it is located, could run software and be interacted with in person by a user as would a personal computer. Any such use of the Goetcheus central facility would be antithetical to the teaching of the reference. Therefore, based on these observations, Applicant further contends that nothing in the prior art teaches the recited use of a personal computer in recording a personal message and, thus, that claim 26 is in condition for immediate allowance.

Turning to claim 27, Applicant first notes that this claim depends from and further limits claim 26, which has been shown to be allowable above, and is therefore itself allowable on that basis alone. Moreover, claim 27 recites that the personal computer and the first recorder-imprinter are located at a first retail location, which method of personal message recording Applicant contends is in no way taught in the art. Specifically, in the Goetcheus reference there is absolutely no suggestion that a customer would interact directly, or in person, with the disclosed central facility computer system or that there would ever be any reason to or advantage in co-locating the central facility and the programmer. Rather, the disclosed central facility is just that: a centralized order-taking and voice mail system that would make no sense to be located at a retail outlet along with the disclosed store front playback device programmer system, and, thus, would not simply be a matter of design choice.

Similarly, claim 28 also depends from claim 26, which, again, alone provides a basis for allowance. Once more, no prior art references teach that a personal computer, regardless of where it is located, would run software and be interacted with in person by a user in recording a personal message to present to a recipient. Thus, Applicant respectfully contends that claim 28 is also in condition for immediate allowance.

Turning now to claim 29, which depends from and further limits claim 25, there is recited a method of recording a personal message including the additional steps of configuring the personal computer with a telephone interface device so as to be connected to a conventional telephone network, locating the personal computer at a first location, installing a telephone line connection between the telephone network and the telephone interface device, placing a telephone call from a remote second location over the telephone network to the first location as an incoming call, receiving the telephone call, and transferring the telephone call to the personal computer over the telephone line connection to begin said step of interacting the software program. At the outset, because this claim further limits claim 25, which has been shown above to be allowable as directed to subject matter not taught by the art, it would follow that claim 29 is also allowable on this basis alone.

Furthermore, regarding the recited steps in claim 29 of placing a telephone call to the first location, or the location of the personal computer, and then transferring the call to the personal computer, Applicant notes that these steps are simply not taught in the art. Again, Ohara does not disclose a personal computer, whether interacted with in person or over the telephone. Goetcheus discloses a central facility computer system or voice message system that is configured to receive calls directly, as in any voice message system. No calls would ever be made to the location of the central facility computer system and then transferred to the central facility; they would be received directly by the central facility. Only if a customer calls the store front location remote from the central facility would the store front transfer the customer's call to the central facility (See column 9, lines 13-17). In other words, the Goetcheus reference only teaches one of two scenarios: (1) calling the central facility directly, in which case no transfer of the call is required; or (2) calling a store front location remote from the central facility and transferring the call to the central facility. Because in Goetcheus the central facility and the store front programmer are never co-located, as discussed above regarding claim 26, Goetcheus does not disclose that a call be received at the location of the central facility and then transferred to it, only that a remote call be transferred to the central facility. Therefore, claim 29 reciting the steps of both calling the location of the personal computer and then transferring the call to the personal computer cannot be anticipated by or made obvious in view of Goetcheus, which actually teaches away from these steps. In essence, these steps only make sense in the system of the present invention wherein a personal computer would ever be co-located with the recorder-imprinter - a system, again, simply not even suggested by the art. For these reasons, Applicant respectfully contends that claim 29 is in condition for immediate allowance.

Claim 30 depends from claim 25 and recites that the step of interacting the software program further comprises co-locating a user and the personal computer and running the software program so as to allow the user to initiate the step of downloading a stored personal message to the first recorder-imprinter. In addition to being allowable as depending from an allowable independent claim, claim 30 is also allowable for the same reasons discussed above regarding claim 26 relating to the lack of any suggestion in the art to utilize a personal computer in the process of recording a personal message to be sent to a recipient, much less co-locating a user and the personal computer so that the personal computer is interacted with in person through the software it is running. Moreover, claim 30 specifically recites that the user interacts with the personal computer's software so as to initiate the downloading of an already stored personal message to a recorder-imprinter.

In contrast to the method of claim 30, the prior art in no way suggests that a user interact with a personal computer to initiate the downloading of a voice message to a recorder-imprinter or the like. Rather, Ohara involves no personal computer whatsoever, and describes the downloading of a voice message to the playback device as initiated by the user as only involving in person direct recording to the playback device through the direct record input device. Initiating the downloading of a message recorded over the telephone in the point-to-point processor is only by a point of sale agent and not a user. Thus, in Ohara, a user never even initiates the downloading of a message by interacting with the point-to-point processor, which is analogous to the recorder-imprinter of the present invention, much less initiating the downloading through a personal computer as recited in claim 30. Likewise, in Goetcheus, it is disclosed at column 5, lines 6-28, that a message stored in the memory of the central facility computer system may be downloaded to a store front programmer system automatically, manually under the control of an operator at the central facility, or manually under the control of an operator at the store front. There is simply no suggestion in the Goetcheus reference that a user would initiate the downloading from the central facility, much less downloading a previously-recorded personal message from a personal computer to a recorder-imprinter. Again, this follows from the observations previously made that in Goetcheus a user would never be co-located with the central facility or otherwise interact with the central facility as a user would the personal computer of the present system. As with Ohara, the only involvement of a user in downloading a message in the Goetcheus system is directly to the playback device when the user is present at the store front. Therefore, neither Goetcheus nor Ohara, nor any other prior art known of, anticipates or makes obvious the method of recording a personal message recited in claim 30, and, on this basis, Applicant contends that this claim is also in condition for immediate allowance.

Turning now to claims 31-33, the method of claim 25 is further limited in that the first recorder-imprinter is located at a first retail location, a second recorder-imprinter is located at a second retail location and includes a second storage device having the personal message stored therein, and the step of interacting the software program further includes uploading the personal message from the second recorder-imprinter to the personal computer.

In contrast to these recited steps, Goetcheus only teaches at column 9, lines 15-17, that a customer's call placed to the store front can be transferred to the central facility, not a previously-recorded personal message. As discussed above regarding claims 16 et al., Goetcheus neither discloses nor suggests that the store front programmer system could be interacted with directly to store a message, much less that a message so stored in a programmer system could be uploaded to the central facility. In Goetcheus, all message recording is to occur at the central facility, such that the only direction a message would be transferred would be from the central facility to store front programmer systems, never from store front programmer systems to the central facility. Therefore, there is simply no teaching in Goetcheus that a personal message would be uploaded from a recorder-imprinter to a personal computer as recited in claim 31. Indeed, Goetcheus teaches away from any such process by touting the advantages of the only disclosed system wherein all messages would, again, be recorded at the central facility and downloaded to a programmer, not uploaded from a programmer. As such, there is no reasonable basis or suggestion for combining the Goetcheus reference with a reference such as U.S. Patent No. 6,167,233 to Gresser to arrive at the claimed invention. Therefore, Applicant respectfully contends that claim 31, and the claims that depend therefrom, are in condition for immediate allowance.

Regarding claim 33, specifically, there is recited the further limitation that the personal computer is located at the first retail location along with the first recorder-imprinter. As with claim 27 discussed above, there is no teaching in the art that a personal computer be co-located with a recorder-imprinter or the like for use in recording a personal message to be sent to a recipient. Moreover, in depending from claim 31, claim 33 includes the further limitation not found in claim 27 wherein the personal message is uploaded to the personal computer from the remote second recorder-imprinter so as to then be downloaded to the co-located first recorder-imprinter. Because such methodology is clearly not taught in or suggested by the prior art, it follows that claim 33 is, again, nonobvious and allowable as submitted.

From the foregoing it is apparent that Applicant has made a valuable contribution to the art. Claims 15-33 now in the case patentably distinguish over the prior art and are in condition for allowance. Consequently, early notice of allowance is respectfully solicited. If the Examiner is not in agreement, it is requested that she feel free to telephone the undersigned to discuss any concerns that may exist regarding allowance.

If any additional fees are required, please charge our Deposit Account No. 21-0800.

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